

U.S. Patent Application Serial No. 10/082,089
Amendment filed April 11, 2005
Reply to OA dated January 12, 2005

REMARKS

Claims 8 and 18-20 are pending in this application. Claim 13 has been canceled herein without prejudice or disclaimer. Claims 8 and 18 have been amended herein.

Support for the amendments to the claims is indicated as follows:

In the amendment to claim 8, the recitation of the releasant dispersed finely in the polyester resin is deleted. Support for this amendment may be found, for example, in claim 8 before the Amendment dated September 9, 2004, in which the recitation of the releasant was added. The amendment to claim 8 also replaces the organic pigment of Formula 1 with the organic pigment of Formula 8 (C.I. Pigment Red 188), as supported by claim 13, claim 13 being canceled without prejudice or disclaimer.

Claim 18 has been amended to be in independent form, incorporating the method limitations of intervening claim 13 (now canceled) and base claim 8 (before the present amendment).

Claims 19 and 20 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (Office action paragraph no. 5)

The rejection of claims 19 and 20 is respectfully traversed, and reconsideration of the rejection is respectfully requested.

Applicant has previously indicated support for claims 19 and 20 on page 38, lines 12-21.

In the rejection, the Examiner states that page 38, lines 12-16, discloses "a method adding dropwise water while stirring **at low shear** employing a stirrer" The Examiner's argument is

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apparently that claims 19 and 20 are broader than the disclosure of the specification, because they are not limited to "at low shear".

In response, Applicant notes that the recitation of "at low shear" in the specification on page 38, line 13, is a generalized description of what **results from the stated conditions** of blade or circumferential speed on page 38, lines 13-17, and is not meant as an additional limitation. The specific blade and circumferential speed conditions are recited as limitations in claims 18 and 19, and Applicant submits that these limitations are fully supported by the specification. Applicant therefore respectfully submits that it would be inappropriate to require recitation of the additional limitation of "low shear" in the claims, in view of how the term is used in the specification.

Claims 8 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over US 6,265,125 B1 (Anno), as evidenced by Japanese Patent 2000-81734 (JP '734), combined with US 5,079,123 (Nanya) and US 6,183,924 B1 (Nomura). See the Derwent translation of JP '734 for cites. (Office action paragraph no. 7).

The rejection of claim 8 is overcome by the amendment to claim 8. Claim 13 has been canceled without prejudice or disclaimer.

In the amendment to claim 8, the recitation of the releasant dispersed finely in the polyester resin is deleted. The amendment to claim 8 replaces the organic pigment of Formula 1 with the organic pigment of Formula 8 (C.I. Pigment Red 188).

The Examiner indicated in paragraph no. 16 of the Office action that the prior art does not

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suggest a method of making spherical toners comprising the pigment of formula 8. Claim 8, as amended, explicitly recites formula 8, and Applicant submits that claim 8 is novel and non-obvious over the cited references.

Claims 8 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Nanya, US 2002/0037466 A1 (Kanbayashi) and Normura. (Office action paragraph no. 8)

The rejection of claim 8 is overcome by the amendments to claims 8. Claim 13 has been canceled without prejudice or disclaimer.

As noted above, claim 8 as amended explicitly recites formula 8, and Applicant submits that claim 8 is novel and non-obvious over the cited references.

Claims 8 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Nanya, Japanese Patent 2000-81734 (JP '734), and Nomura. See Derwent translation of JP '734 for cites. (Office action paragraph no. 9)

The rejection of claim 8 is overcome by the amendments to claims 8. Claim 13 has been canceled without prejudice or disclaimer.

As noted above, claim 8 as amended explicitly recites formula 8, and Applicant submits that claim 8 is novel and non-obvious over the cited references.

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Claims 8 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Anno combined with Nanya, US 2002/0047193 A1 (Tosaka), as evidenced by the ACS file Registry Nos. 56396-10-2, 6448-96-0, and 12225-06-8 and Nomura. (Office action paragraph no. 10)

The rejection of claim 8 is overcome by the amendments to claims 8. Claim 13 has been canceled without prejudice or disclaimer.

As noted above, claim 8 as amended explicitly recites formula 8, and Applicant submits that claim 8 is novel and non-obvious over the cited references.

Claims 8, 13, 19 and 20 are rejected under 35 U.S.C. §103(a) as being obvious over US 6,821,697 B2 (Takayanagi) combined with Kanbayashi. (Office action paragraph no. 13)

The rejection is respectfully traversed, in accordance with 35 U.S.C. 103(c) and MPEP 706.02(l)(2)II, as stated below. Takayanagi '697 is therefore not prior art under 35 U.S.C. 103(a) for the present claims.

Statement in accordance with 35 U.S.C. 103(c):

In accordance with 35 U.S.C. 103(c), Applicant states that Takayanagi US 6,821,697 and the presently claimed invention were, at the time the invention was made, commonly owned or subject to assignment to Dainippon Ink and Chemicals, Inc.

Claims 8, 13, 19 and 20 are rejected under 35 U.S.C. §103(a) as being obvious over Takayanagi combined with JP '734. See the Derwent translation of JP '734 for cites. (Office

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action paragraph no. 14)

The rejection is respectfully traversed. In accordance with 35 U.S.C. 103(c), Applicant has stated above that Takayanagi US 6,821,697 and the presently claimed invention were, at the time the invention was made, commonly owned or subject to assignment to Dainippon Ink and Chemicals, Inc. Takayanagi '697 is therefore not prior art under 35 U.S.C. 103(a) for the present claims.

Claims 8, 13, 19 and 20 are rejected under 35 U.S.C. §103(a) as being obvious over Takayanagi combined with Tosaka, as evidenced by the ACS File Registry Nos. 6448-96-0, 56396-10-2, and 12225-06-8. (Office action paragraph no. 15)

The rejection is respectfully traversed. In accordance with 35 U.S.C. 103(c), Applicant has stated above that Takayanagi US 6,821,697 and the presently claimed invention were, at the time the invention was made, commonly owned or subject to assignment to Dainippon Ink and Chemicals, Inc. Takayanagi '697 is therefore not prior art under 35 U.S.C. 103(a) for the present claims.

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Office action paragraph no. 16)

The objection is overcome by the amendment to claim 18, placing claim 18 in independent form, incorporating the limitations of base claim 8 and intervening claim 13.

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In view of the aforementioned amendments and accompanying remarks, the claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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